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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/529,482	06/19/00	WATTS	R. DYC-011

003897 QZ11/1023  
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EXAMINER	
HAMILTON, L	
ART UNIT	PAPER NUMBER

3764

DATE MAILED: 10/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/529,482

Applicant(s)

WATTS, ROBERT J.

Examiner

HAMILTON

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

  
SHARON N. THORNTON  
PATENT ANALYST

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

Figures 1a-b and 2a-b should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "sock-like" is indefinite.

Claim 3 recites the limitation "the ends" in 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "closing means" in 11. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 10-11, 15, 17-18, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillip ('934) in view of Brandt ('000).

Phillip discloses the invention substantially as claimed; however, Phillip does not disclose inserts made of silicone or 35 shore silicone elastomer. Brandt teaches an ankle device having inserts made of silicone (col.6, lines 1-2) and 35 shore silicone elastomer (col.9, line 60 to col.10, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the 35 shore silicone elastomer taught by Brandt onto the device taught by Phillip to provide suitable resilience. The orthosis being skin colored and adapted to fit various sizes is a choice of design.

Claims 7, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillip and Brandt, as applied to claims 1, 4, and 11 above, and further in view of Wilkerson ('603).

Phillip discloses and Brandt teaches the invention substantially as claimed; however, neither reference discloses nor teaches a rib of polypropylene, a set of hooks and loops, or enveloping the plantar aspect of the foot without enveloping the calcaneum. Wilkerson teaches a rigid shell made of polypropylene (col.4, lines 1-5), a set of hooks and loops (col.5, lines 10-53), and enveloping the plantar aspect of the foot without enveloping the calcaneum (fig.1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a rib of polypropylene, a set of hooks and loops, and enveloping the plantar aspect of the foot without enveloping the calcaneum onto the device disclosed by Phillip and taught by Brandt to provide a means of supporting the ankle.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillip and Brandt as applied to claim 4 above, and further in view of Hefe ('900).

Phillip discloses and Brandt teaches the invention substantially as claimed; however, neither reference discloses nor teaches a rib of carbon fiber. Hefe teaches a stiffening layer made of carbon fiber (col.2, lines 50-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the carbon fiber taught by Hefe onto the device disclosed by Phillip and taught by Brandt to provide suitable resilience.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillip and Brandt as applied to claim 11 above, and further in view of Caprio ('844).

Phillip discloses and Brandt teaches the invention substantially as claimed; however, neither reference discloses nor teaches a zip fastener. Caprio teaches an ankle supporter that may incorporate the use of zippers as a means of closure (col.3, lines 23-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the zipper closure taught by Caprio onto the device disclosed by Phillip and taught by Brandt to provide an alternative means of closure.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over as Phillip and Brandt, as applied to claim 1 above, and further in view of Boudon ('668). Phillip discloses and Brandt teaches the invention substantially as claimed; however, neither reference discloses nor teaches an orthosis fabricated from injection molding and stamped and pressed from sheet material. Boudon teaches an ankle device that is

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fabricated from injection molding and stamped and pressed from sheet material (col.2, lines 15-25). ). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the orthosis fabricated from injection molding and stamped and pressed from sheet material onto the device disclosed by Phillip and taught by Brandt to provide a more precise fit.

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillip in view of Wilkerson.

Phillip discloses the invention substantially as claimed; however, Phillip does not disclose a second strap means. Wilkerson teaches an ankle device having a second strap means (fig.1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an second strap means to provide additional securing means to the foot of the user.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillip.

Philip discloses a resilient rib (30), a means for securing the device to the foot (3, 5, and 13), an adhesive securing means (col.4, lines 55-60), and ortholene (col.4, lines 35-45).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Brown can be reached on (703) 308-2682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4520 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-

2272.



LMH

October 22, 2001



Michael A. Brown  
Primary Examiner